

REMARKS

In the Final Office Action, the Examiner rejected claims 1-24. In this Amendment and Response, Applicants amended claims 1, 10-13, 15-19, and 21-23 to clarify certain features of the instant claims. These amendments do not add any new matter. In view of the foregoing amendments and the following remarks, Applicants respectfully request reconsideration and allowance of the pending claims 1-24.

Rejections under 35 U.S.C. § 102

In the Office Action, the Examiner rejected claims 1, 3, 4, 6-8, 10, and 14-17 under 35 U.S.C. § 102(a) as anticipated by Wambach et al. (U.S. Patent No. 6,330,648). Additionally, the Examiner rejected claims 1, 10, 18, 19, and 22-24 under 35 U.S.C. § 102(e) as anticipated by MacLeod (U.S. Patent No. 6,598,135). Applicants respectfully traverse these rejections.

Legal Precedent

First, when construing claims, the Federal Circuit has consistently looked first to dictionaries, encyclopedias, and treatises, which were publicly available at the time the patent issued, to determine the ordinary and custom meanings of terms used in claims. As stated in *Texas Digital Systems, Inc. v. Telegenix, Inc.*, 308 F.3d 1193, 1202-03:

Such references are unbiased reflections of common understanding not influenced by expert testimony or events subsequent to the fixing of the intrinsic record by the grant of the patent, not colored by the motives of the parties, and not inspired by litigation. Indeed, these materials may be the most meaningful source of information to assist judges in better understanding both the technology and the terminology used by those skilled in the art to describe the technology.

The *Texas Digital* court further stated that “[c]onsulting the written description and prosecution history as a threshold step in the claim construction process, before any effort is made to discern the ordinary and customary meanings attributed to the words themselves, invites a violation of our precedent counseling against importing limitations into the claims.” *Id.* at 1204 (cited with approval in *Intellectual Property Development Inc. v. UA-Columbia Cablevision of Westchester Inc.*, 67 U.S.P.Q. 2d 1385, 1389 (Fed. Cir. 2003)).

Second, anticipation under section 102 can be found only if a single reference shows exactly what is claimed. *Titanium Metals Corp. v. Banner*, 778 F.2d 775, 227 U.S.P.Q. 773 (Fed. Cir. 1985). For a prior art reference to anticipate under section 102, every element of the claimed invention must be identically shown in a single reference. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). To maintain a proper rejection under section 102, a single reference must teach each and every limitation of the rejected claim. *Atlas Powder v. E.I. du Pont*, 750 F.2d 1569 (Fed. Cir. 1984). Accordingly, the Applicants need only point to a single element not found in the cited reference to demonstrate that the cited reference fails to anticipate the claimed subject matter. The prior art reference also must show the *identical* invention “in as complete detail as contained in the ... claim” to support a *prima facie* case of anticipation. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q. 2d 1913, 1920 (Fed. Cir. 1989).

Third, if the Examiner relies on a theory of inherency, the extrinsic evidence must make clear that the missing descriptive matter is *necessarily* present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. *In re*

Robertson, 169 F.3d 743, 49 U.S.P.Q.2d 1949 (Fed. Cir. 1999) (Emphasis Added). The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient. *Id.* In relying upon the theory of inherency, the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). The Examiner, in presenting the inherency argument, bears the evidentiary burden and must adequately satisfy this burden. *See id.* Regarding functional limitations, the Examiner must evaluate and consider the functional limitation, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context in which it is used. *See* M.P.E.P. § 2173.05(g); *In re Swinehart*, 169 U.S.P.Q. 226, 229 (C.C.P.A. 1971); *In re Schreiber*, 44 U.S.P.Q.2d 1429, 1432 (Fed. Cir. 1997). If the Examiner believes the functional limitation to be inherent in the cited reference, then the Examiner “must provide some evidence or scientific reasoning to establish the reasonableness of the examiner’s belief that the functional limitation is an inherent characteristic of the prior art.” *Ex parte Skinner*, 2 U.S.P.Q.2d 1788, 1789 (Bd. Pat. App. & Inter. 1986).

Claim Features Missing in Wambach

First, as discussed above, the Examiner rejected independent claims 1 and 10 and dependent claims 3, 4, 6-8, and 14-17 under 35 U.S.C. § 102(a) as being anticipated by Wambach. However, Applicants respectfully stress that the Wambach reference fails to disclose each and every feature of the instant claims.

Turning to the claims, independent claim 1 recites, *inter alia*, “identifying the write protect status of the computer diskette based on the failure code.” Independent claim 10 recites, *inter alia*, “identifying the write protect status of the floppy diskette based on the failure code.”

The ordinary meaning of “floppy disk” is: “a removable and widely used data storage medium that uses a magnetically coated flexible disk of Mylar enclosed in a plastic envelope or case.” WEBSTER’S NEW WORLD COMPUTER DICTIONARY 147 (10th Ed. 2003); *see also*, MICROSOFT COMPUTER DICTIONARY 218 (5th Ed. 2002). Similarly, the ordinary meaning of “diskette” refers to a “floppy disk.” *See* WEBSTER’S NEW WORLD COMPUTER DICTIONARY 114 (10th Ed. 2003); *see also*, MICROSOFT COMPUTER DICTIONARY 165 (5th Ed. 2002).

In sharp contrast, the Wambach reference discloses “mass memory 120, such as a magnetic hard drive, connected to the controller card 115 by a bus 125.” Wambach, Fig. 1; Col. 3, lines 50-52. The ordinary meaning of “hard drive” is: “a secondary storage medium that uses several rigid disks coated with a magnetically sensitive material and housed together with the recording heads in a hermetically sealed mechanism.” WEBSTER’S NEW WORLD COMPUTER DICTIONARY 167 (10th Ed. 2003); *see also*, MICROSOFT COMPUTER DICTIONARY 246 (5th Ed. 2002) (comparing a hard disk to a floppy disk). In view of these ordinary meanings of computer diskette, floppy disk, and hard disk, the Applicants stress that the Examiner’s rejection is improper and cannot stand. The foregoing legal precedent clearly gives great deference to dictionaries in determining the ordinary meaning of claim terms. For

this reason, the Applicants emphasize that the Wambach reference fails to teach or suggest each and every element recited by the instant claims.

Accordingly, the Applicants respectfully request that the Examiner withdraw the rejection of independent claims 1 and 10 and dependent claims 3, 4, 6-8, and 14-17 under 35 U.S.C. § 102(a) in view of Wambach.

Claim Features Missing in MacLeod

Second, as discussed above, the Examiner rejected independent claims 1, 10, and 18 and dependent claims 19 and 22-24 under section 102 as being anticipated by MacLeod. Again, Applicants respectfully stress that the MacLeod reference fails to disclose each and every feature of the instant claims.

Turning to the claims, independent claim 1 recites, *inter alia*, “identifying the write protect status of the computer diskette based on the failure code.” Independent claim 10 recites, *inter alia*, “identifying the write protect status of the floppy diskette based on the failure code.” Independent claim 18 recites, *inter alia*, “identifying the write protect status of the computer diskette as write protected if a write protect error code is observed.”

As discussed in detail above, the ordinary meaning of “floppy disk” is: “a removable and widely used data storage medium that uses a magnetically coated flexible disk of Mylar enclosed in a plastic envelope or case.” WEBSTER’S NEW WORLD COMPUTER DICTIONARY 147 (10th Ed. 2003); *see also*, MICROSOFT COMPUTER DICTIONARY 218 (5th Ed. 2002).

Similarly, the ordinary meaning of “diskette” refers to a “floppy disk.” *See* WEBSTER’S NEW WORLD COMPUTER DICTIONARY 114 (10th Ed. 2003); *see also*, MICROSOFT COMPUTER DICTIONARY 165 (5th Ed. 2002).

In sharp contrast, the MacLeod reference discloses DVD media. *See* MacLeod, Abstract. The ordinary meaning of “DVD” is a “Digital Video Disc,” which may be defined as a “CD-ROM format capable of storing up to a maximum of 17GB of data.” WEBSTER’S NEW WORLD COMPUTER DICTIONARY 122 (10th Ed. 2003); *see also*, MICROSOFT COMPUTER DICTIONARY 160 (5th Ed. 2002) (defining DVD as: “The next generation of optical disc storage technology.”). The ordinary meaning of “CD” is a “Compact Disc,” which may be defined as “a read only optical disc format.” WEBSTER’S NEW WORLD COMPUTER DICTIONARY 64 (10th Ed. 2003). In view of these ordinary meanings of computer diskette, floppy disk, and DVD, the Applicants stress that the Examiner’s rejection is improper and cannot stand. The foregoing legal precedent clearly gives great deference to dictionaries in determining the ordinary meaning of claim terms. For this reason, the Applicants emphasize that the MacLeod reference fails to teach or suggest each and every element recited by the instant claims.

Accordingly, the Applicants respectfully request that the Examiner withdraw the rejection of independent claims 1, 10, and 18 and dependent claims 19 and 22-24 under 35 U.S.C. § 102(a) in view of MacLeod.

Rejections under 35 U.S.C. § 103

In the Final Office Action, the Examiner rejected claims 2, 5, 9, 11-13, 20, and 21 under 35 U.S.C. § 103(a) as unpatentable over Wambach et al. and MacLeod. Applicants respectfully traverse these rejections.

Legal Precedent

First, the burden of establishing a *prima facie* case of obviousness falls on the Examiner. *Ex parte Wolters and Kuypers*, 214 U.S.P.Q. 735 (PTO Bd. App. 1979). Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention absent some teaching or suggestion supporting the combination. *ACS Hospital Systems, Inc. v. Montefiore Hospital*, 732 F.2d 1572, 1577, 221 U.S.P.Q. 929, 933 (Fed. Cir. 1984). The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d. 1430 (Fed. Cir. 1990). Accordingly, to establish a *prima facie* case, the Examiner must not only show that the combination includes *all* of the claimed elements, but also a convincing line of reason as to why one of ordinary skill in the art would have found the claimed invention to have been obvious in light of the teachings of the references. *Ex parte Clapp*, 227 U.S.P.Q. 972 (B.P.A.I. 1985). The Examiner must provide objective evidence, rather than subjective belief and unknown authority, of the requisite motivation or suggestion to combine or modify the cited references. *In re Lee*, 61 U.S.P.Q.2d. 1430 (Fed. Cir. 2002). Moreover, a statement that the proposed modification would have been “well within the ordinary skill of the art” based on individual knowledge of the claimed elements cannot be relied upon to establish a *prima facie* case of

obviousness without some *objective reason to combine* the teachings of the references. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300 (Bd. Pat. App. & Inter. 1993); *In re Kotzab*, 217 F.3d 1365, 1371, 55 U.S.P.Q.2d 1313, 1318 (Fed. Cir. 2000); *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 U.S.P.Q.2d 1161 (Fed. Cir. 1999).

Second, when prior art references require a selected combination to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gained from the invention itself, i.e., something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination. *Uniroyal Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 U.S.P.Q.2d 1434 (Fed. Cir. 1988). One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988).

Third, it is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); M.P.E.P. § 2145. Moreover, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959); *see* M.P.E.P. § 2143.01. Similarly, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984); *see* M.P.E.P. § 2143.01.

Fourth, in order to rely on equivalence as a rationale supporting an obviousness rejection, the equivalency must be recognized in the prior art, and cannot be based on applicant's disclosure or the mere fact that the components at issue are functional or mechanical equivalents. *In re Ruff*, 256 F.2d 590, 118 U.S.P.Q. 340 (CCPA 1958); *see also* M.P.E.P. § 2144.06.

Claim Features Missing in Cited References

Claims 2, 5, 9, 11-13, 20, and 21 depend from independent claims 1, 10, and 18, respectively. As discussed above, Applicants assert that these references both fail to disclose certain features recited by independent claims 1, 10, and 18. Moreover, the cited references do not obviate the deficiencies of one another. For these reasons, the cited references, taken alone or in combination, fail to teach or suggest the instant claims.

Improper Combination: Wambach and MacLeod Teach Away from One Another

In addition to the foregoing claim deficiencies, the Applicants emphasize that the Wambach and MacLeod references teach away from one another. Moreover, the proposed combination would change the principles of operation of each respective reference, thereby rendering the systems of Wambach and MacLeod inoperable for their intended purposes.

Turning to the first reference, Wambach discloses a *principle of operation* involving the use of a write protection *circuit* 160 and a *list* of protected mass memory locations. *See* Wambach, Col. 4, lines 8-22. In operation, a write protection circuit 160 compares the list

against the mass memory specified in each write request. *See* Wambach, Col. 4, lines 23-27.

If the write protection circuit 160 finds a match between the list and the write request, then the write protection circuit 160 aborts the write request and notifies the host computer 100.

See Wambach, Col. 4, lines 27-30. Thus, the *principle of operation* of Wambach is based on the use of this *list* of protected mass memory locations.

In sharp contrast, the MacLeod reference discloses a *principle of operation* using coded switches or *flags*, which are either “set” or “not set” to control write operations. *See* MacLeod, Col. 5, lines 5-33. More specifically, MacLeod teaches the use of both a Write-Protect Flag (WPF) and a Sector Written Flag (SWF) *within each sector* of the DVD-WORM media. *See id.* In operation, these flags, i.e., WPF and SWF, are both checked prior to allowing a write operation to the particular sector. *See id.* The write operation is allowed only if both flags are “not set,” while the write operation is prevented if both flags are “set.” In addition, if one flag is “set” and the other flag is “not set,” then the flags are re-read 2 times. *See id.* If these additional evaluations identify different flag settings, then the foregoing rules apply, otherwise a repeated mismatch of “set” and “not set” flags will prevent a write operation. *See id.* Thus, the *principle of operation* of MacLeod is based on the use of these different *flags*, i.e., WPF and SWF.


In view of these different principles of operation, the Examiner's proposed combination of Wambach and MacLeod is improper and cannot stand. For these reasons, Applicants respectfully request the Examiner withdraw the rejections under 35 U.S.C. § 103.

Conclusion

In view of the foregoing Amendments and Remarks, the Applicants respectfully assert that the pending claims 1-24 are in condition for allowance. If the Examiner believes that a telephonic interview will help speed this application toward issuance, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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